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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/660,856

09/12/2003

Theodore A. Chapman

M-15268 US

8641

7590

11/16/2004

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EXAMINER

CHAU, MINH H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,856

Applicant(s)

CHAPMAN ET AL.

Examiner

Minh H Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) ✓  
Paper No(s)/Mail Date 09/13/2003.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election **without** traverse of Group C, Claims 22-29 in the reply filed on August 05, 2004 is acknowledged. Claims 1-21 and 30-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 22-27 and 29** are rejected under 35 U.S.C. 102(b) as being anticipated by Heredia et al. (US # 6,327,972).

**With respect to claims 22 and 26**, Heredia et al. teach a method for printing labels (23) from a roll (21), with each label having transponder chip or RFID tag (26), the method comprising passing a label (23) over an antenna or RFID antenna (20), interrogating the RFID tag in the label, determining if the interrogating was successful, attempting N-1 additional interrogations until a successful interrogation is determined; and printing the label once a successful interrogation is determined (see Figs. 1-2 and cols. 3-6 of Heredia et al.)

With respect to the recitation of “attempting N-1... determined”, this method step is directly depending on the value on N and since the N value in claim 1 can be any number therefore, if N=1, then there is no additional attempting interrogation is required. This also applied to claim 26, which recites, “N is 5 or less”. Therefore, if N=1 then there is also no additional attempting interrogation is required.

**With respect to claim 23**, see col. 4 of Heredia et al. that teach the step of receiving print and tag data from a host computer (17).

**With respect to claim 24**, see col. 5 of Heredia et al. that teach the step of interrogating is reading data from the transponder chip or RFID tag (26).

**With respect to claim 25**, see col. 5 of Heredia et al. that teach the step of interrogating is programming data in the transponder chip or RFID tag (26).

**With respect to claim 27**, see col. 5, line 55 through col. 6, line 3 of Heredia et al. that teach the step of colored black or over striking the label if a successful interrogation cannot be determined after N interrogations.

**With respect to claim 29**, see col. 3, lines 59-60 of Heredia et al. that teach the step of printing is by the thermal printing.

#### ***Allowable Subject Matter***

4. **Claim 28** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter:

**Claim 28** has been indicated for containing allowable subject matter because the entire combination of a method for printing label from a roll including the step of halting operation of the process if a successful interrogation cannot be determined after N interrogations could not be found in the prior art of record.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant's attention is invited to the patents to Wiklof et al. (US # 6,246,326), Petteruti et al. (US # 6,409,401), Banach et al. (US# 6,481,907) and Moylan et al. (Pub. No. US 2004/32443 A1).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

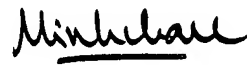
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Minh H Chau", with a horizontal line drawn underneath the name.

MHC  
November 12, 2004

Minh H Chau  
Primary Examiner  
Art Unit 2854